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RemarksStatus of the Claims

Claims 1-16 are pending. Claims 1-16 are subject to an Election/Restriction requirement. Claim 3 is rejected under 35 U.S.C. 112, second paragraph. Claims 1-3 and 7-16 are rejected under the judicially created doctrine of obviousness-type double patenting. Claims 3-6 are herein canceled.

Restriction/Election Requirement

The Examiner has restricted the invention into the following two groups:

Group I: Claims 1-3 and 7-16, drawn to a compounds, pharmaceutical composition and a method of use, classified in class 546, 514 subclass 268.1; and

Group II: Claims 4-6, drawn to various methods of treating diseases, classified in class 514 and various subclasses.

The Examiner contends that Group I and II inventions are distinct and that different searches will be required. Applicants traverse this restriction on the basis of the procedures set forth in the Manual of Patent Examining Procedure ("MPEP").

The MPEP states that "[i]f the search and examination of an entire application can be made without serious burden, the examiner must examine it on the merits, even though it includes claims to distinct or independent inventions." MPEP § 803. Applicants respectfully submit that a search for the Group I compounds compositions and uses and Group II methods could be carried out simultaneously. A search for a compound of the invention would reveal any art for methods of using the compound and compositions

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comprising the compound. Thus, there would be no serious search burden on the Examiner if restriction were not required.

Applicants therefore respectfully request that the Examiner consider Group I and II together. If the Examiner does not agree with this proposal, pursuant to 37 C.F.R. § 1.143, applicants affirm the provisional election made in a telephone conversation on July 6, 2004 with traverse the claims of Group I (claims 1-3 and 7-16) for initial substantive examination. This election is made expressly without waiver of their rights to file for and obtain claims directed to the unelected subject matter in divisional or continuing applications claiming priority and benefit from this application under 35 U.S.C. § 120.

Applicants reserve the right to request rejoinder of claims 4-6 with the elected group if and when any of claims 1-3 and 7-16 are found allowable.

Rejection under 35 U.S.C. 112, Second Paragraph

Claim 3 was rejected under 35 U.S.C. 112, second paragraph, for allegedly being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicants regard as the invention. Without stipulating to the substance of the rejection, Applicants herein cancel claim 3 in the interests of expediting the allowance of the application. Applicants reserve the right to argue the substance of this rejection in this, or any future or pending application.

Rejection under Double Patenting

Claims 1-3 and 7-16 were rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 17-19 of U.S. Patent No. 6,498,168.

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Claims 1-3 and 7-16 were provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 17-19 of co-pending Application No. 10/457,256.

Without stipulating to the substance of the rejection, Applicants herewith submit Terminal Disclaimers with respect to U.S. Patent No. 6,498,168 and Application No. 10/457,256. These terminal disclaimers overcome the rejections under double patenting.

Conclusion

By the above-cited claim cancellations and terminal disclaimers, Applicants have overcome all the rejections of the outstanding Office Action. Hence, claims 1, 2, and 7-16 are in condition for allowance, which timely allowance the Examiner is respectfully requested to grant.

Authorization

As this Amendment is being filed within the three-month period following the shortened statutory period for reply to the Office Action, the Commissioner is hereby petitioned for a three-month extension of time. The Commissioner is hereby authorized to draw the required amount from Applicants' deposit account no. 19-0365. Should any further extension or any other fee become necessary to render this Amendment timely filed and to allow entry of the Amendment, the Commissioner is hereby petitioned for such extension and is authorized to draw the required amount from Applicants' deposit account no. 19-0365.

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Should the Examiner feel that a telephone conference with Applicants' representatives would assist the Examiner, she is invited to telephone the undersigned at anytime. Applicants request favorable consideration of the application and early allowance of the pending claims.

Respectfully submitted,



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January 12, 2005
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